

REMARKS

Claims 1-51 are pending in the application, claims 1-4, 6-29, and 31-51 stand rejected, and claims 5 and 30 stand objected to.

Double Patenting

Claims 1-51 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-33 of co-pending application No. 10/904,000. Applicants hereby submit a Terminal Disclaimer directed to this co-pending application and submit that this rejection is now moot.

Rejection under 35 U.S.C. 103

Claims 1-4, 6-16, 23-29, 31-40 and 47-51 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,539,393 to Kabala in view of U.S. Pat. No. 5,963,944 to Adams and JP Patent No. 11096230 to Sumi. Claims 17 and 41 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Kabala and Sumi and further in view of U.S. Patent Application Publication No. 20020165731 to Dempsey. Claims 18-22 and 42-46 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Kabala, Adams, and Sumi, and further in view of U.S. Patent Application Publication No. 20020174021 to Chu.

Applicants respectfully disagree, and submit that the asserted combination of art does not anticipate each and every claimed element and furthermore is not a proper combination for a 35 USC §103 rejection as set forth in the MPEP as well as the new *KSR v. Teleflex* Examination Guidelines of October 10, 2007.

At the outset, Applicants note that the asserted combination runs contrary to the teachings of the references themselves and is groundless in view of the level of skill in the art. The Kabala and Sumi references are both directed to tracking the movements of users (persons) through a space such as an exhibition hall and gauging their interest in certain particular exhibits. Adams, on the other hand, is directed to a method of managing data distributed across different nodes in a computer network. The Examiner points specifically to Adams' tracking of autonomous

agents, but in Adams “ ‘agent’ refers to an *executable script program* that uses specific interfaces to move among computing environments and to perform a specific function in the environments it visits.” Applicants submit that there is no reason a skilled person looking to track the unpredictable movements of a real person (a *human being*) through a real space would consult a reference that discusses tracking how *computer programs*, following their pre-programmed rules, move across a computer network. The Examiner’s proffered reason that “a motivation for doing so would have been to enhance user’s participation by providing to the user information based on estimated interests” simply has no relevance to the executable script programs (agents) of Adams - after all, “estimating interests” makes no sense in the context of executable script programs, and neither does “enhancing participation.” As Adams clearly discloses, his method is directed to assessing the stigmergy of a network, which he likens to the movement of ants “as each ant responds to the conditions in its immediate vicinity in a simple, predictable way.” The movements of humans are rarely simple and never predictable, and a skilled person interested in predicting such human behavior as per the methods of Kabala and Sumi would simply have no use for Adams’ teachings for tracking “simple, predictable” movements such as those of executable script programs.

Applicants further respectfully disagree that Sumi discloses a method wherein data about current *strength* of stored markers is used to provide a relevant information item, as alleged by the Examiner. All that Sumi discloses is a system that “estimates the interests of the visitor by using the *current position* and *visiting history*.” Neither current position nor visiting history of a visitor are anticipatory of the current strength of a stored marker.

From the erroneous assertion that Sumi discloses a method wherein data about current strength of stored markers is used to provide an information item relevant to the use of a space, the Examiner draws the unexplained and inexplicable conclusion that “one skilled in the art would immediately conceptualize that as the user moves from location to location, data corresponding to the user’s interests and data relevant to the use of the location is being provided to the user.” Applicants disagree, and respectfully ask, why would a skilled person “immediately conceptualize” all this? The Examiner offers not one word of explanation beyond this bland assertion, in direct contradiction to the requirements for a proper §103 rejection, as set forth

below.

In particular, Applicants note that the new Guidelines provide that “When making an obviousness rejection, Office personnel must therefore ensure that the written record includes findings of fact concerning the state of the art and the teachings of the references applied. In certain circumstances, it may also be important to include explicit findings as to how a person of ordinary skill would have understood prior art teachings, or what a person of ordinary skill would have known or could have done. Factual findings made by Office personnel are the necessary underpinnings to establish obviousness.” There are no such factual findings in the present Action, rather in their stead only conclusory statements as to what the skilled person, according to the Examiner’s unsupported and unexplained opinion, would allegedly have done.

The Guidelines further admonish that “Although a rejection need not be based on a teaching or suggestion to combine, a preferred search will be directed to finding references that provide such a teaching or suggestion if they exist.” The Examiner has not even acknowledged this pronouncement, much less provided a reason for the complete lack of such teaching or suggestion in any of the cited references. The motivation proffered by the Examiner is nowhere to be found in the references and, as noted above, is essentially baseless in the context of the asserted references.

The Guidelines further set forth that “Any obviousness rejection should include, either explicitly or implicitly in view of the prior art applied, an indication of the level of ordinary skill.” No such indication, explicit or implicit, is to be found in the Examiner’s Action.

Perhaps the most instructive portion of the Guidelines is the clear statement that “The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Court quoting *In re Kahn* stated that “ ‘[R]jections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.’ ” Again, rather than offer articulated reasoning with some rational underpinning, the Examiner merely asserts a conclusion of obviousness.

These Guidelines do make clear that “the familiar teaching-suggestion-motivation (TSM) rationale” can still be employed by Examiners in making an obviousness rejection. However, as noted above, the Examiner has not even mentioned where such suggestion is allegedly to be found in either of the cited references, rather merely offered his own, unfounded motivation.

In view of all of the above, Applicants respectfully submit that the three references combined by the Examiner do not anticipate the presently claimed invention and that regardless, these references are not in fact a proper combination for a §103 rejection, and thus request the Examiner to kindly reconsider and pass all claims to issue.

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Applicants acknowledge with gratitude the Examiner’s indication of allowability as to claims 5 and 30, but in view of the preceding respectfully submit that all pending claims are in fact novel and non-obvious over the art on record.

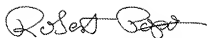
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The Commissioner is authorized to charge any additional fees that may be required or credit overpayment to deposit account no. 08-2025. In particular, if this response is not timely filed, the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136(a) requesting an extension of time of the number of months necessary to make this response timely filed and the petition fee due in connection therewith may be charged to deposit account no. 08-2025.

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